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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/487,387

Applicant(s)

LOPEZ, JR., LEONARD H.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

On 18 January 2000, applicant filed the instant application; there are no claims to priority. This application is related to application 09/825734, filed on 4 April 2001 which is a continuation in part of application 09/487392, filed 18 January 2000.

On 18 June 2002, the Examiner issued a first non-final office action, rejecting claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Sevcik (US Patent 6,330,542).

On 11 February 2003, the Examiner issued a second non-final office action, rejecting claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Sevcik (US Patent 6,330,542).

On 10 June 2003, applicant amended and traversed rejection.

On 10 September 2003, the Examiner issued a final office action, rejecting claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Sevcik (US Patent 6,330,542).

On 10 December 2003, applicant filed a first request for continuing examination.

On 24 March 2004, a non-final action, the Examiner rejected the claims under 35 U.S.C. 103(a) as being unpatentable over King et al. (US 5,956,737) in view of Arledge (US 6,535,294).

On 22 July 2004, applicant amended claims and traversed rejection.

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On 20 October 2004, the Examiner issued a final Office Action, rejecting claims 1-24 under 35 U.S.C. 103(a) as being unpatentable over Lavery et al. (US 6791707) in view of ImageX.com SEC filing of 12 May 1999.

On 20 April 2005, applicant filed a second request for continuing examination and submitted an affidavit under 37 CFR 1.131.

The present Office Action is a response to applicant's last submission.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 April 2005 has been entered.

Response to Amendment

On 20 April 2005, applicant amended claims 1, 7-11, 13 and 16. applicant also two affidavits under 37 CFR 1.131.

Claims 1-24 are pending and will be examined.

35 USC 101 Rejection

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior action.

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Claims 1, 21 and claims dependent thereupon are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

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In this case, claim 1 and claims dependent thereupon are directed to a system that consists of a record [a data structure], profile(s) [data structures], and two interfaces [software]. The claim contains terms and language that implies but does not positively recite aspects of applicant's invention.

...a **record**, which applicant labels "...a company-tailored prototypical product record..." the record appears to comprise a template (i.e., another record layout) and a variety of fields, which applicant refers to as "...information elements..." that is, data fields and data.

...**profile(s)**, which applicant refers to as "...user-indicative profile..." and "...company-indicative profile...", that is a data structure.

...a [first] **interface**, which applicant refers to as "...internet-accessible purchasing interface that enables a [user, which applicant refers to as a company representative to do something]...", that is, software per se.

...a [second] **interface** which applicant refers to as a "...internet-accessible requestor interface that enables a user to...[do something]...", again, software per se.

The above interpretation of claim 1 is supported by evidence found in claim 11, which states that the system further comprises a **server site for hosting** [the two interfaces] the software.

Claim 21 is directed to:

...a [computerized] representation ..., that is an image.

...[customized] templates..., that is a data structure,

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...[predefined informational...] content , that is, data per se.

...a [requestor] interface...software per se as above.

...a [process] interface..., again, software per se.

Technology recited in preamble

As to technological arts recited in the **preamble**, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In claims 1-24, the terms **automated, automatically and automated print order system** imply the use of technology to various actions of the claimed system. The term automatic is defined as largely or wholly involuntary.¹ Mere use of the term and its derivatives does not overcome the fact that the claims appear to be drawn to records, data structures and software per se.

Nominal recitation of technology

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. Claim 21, for example refers to a "...computerized

¹ Definition of *automatic*, MERRIAM WEBSTERS Collegiate Dictionary.

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representation..." but appears to refer to actions that take place outside the metes and bounds of the claim.

State Street Analysis

Despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, the courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Thus, in order for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. [*"Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue*

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experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]

In the present case, the descriptive language noted above fails to breathe life into the claim limitations, since many of the properties are implied, not positively recited, and appear to take place outside the metes and bounds of the various claims.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ***purchasing interface*** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The Examiner believes that applicant intends to refer to ***purchaser interface***, reference 33.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional

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replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claim 1 and claims dependent thereupon are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The various labels applied to the product renders several claims indefinite or lacking antecedent basis. In some claims, the use of one term or another appears to broaden the scope of a parent claim. In other claims, applicant's use of "...card **or** stationery product..." would render the claims indefinite. For purposes of this Examination, the terms will be interpreted as synonyms:

- ...institutional business cards **and** stationery products (claim 1, preamble)
- ...company-tailored business card **or** stationery product (claims 1)
- ...select a company-tailored business card or stationery product (claim 1)
- ...said tailored product (claims 1, 18, 19).
- ...said company tailored product (claim 20)
- ...company-tailored prototypical product record, claim 1 and prototypical product records (claim 3)

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Claim 1 refers to a requestor interface that enables a user to do certain things, including:

- ...an internet-accessible requestor interface that enables a user
 - to select one of the said one or more predeterminable profiles
 - to select and order a company-tailored business card or stationery product to be printed according to the company-tailored prototypical product record and the selected predeterminable profile and
 - to submit a print order for the selected company-tailored business card or stationery product,

It is not clear what the difference is between ...to select and **order**

[...products...]... and ...to submit a print order [...for selected products...]

Claim 1, directed to a system, contains terms and language that implies but does not positively recite aspects of applicant's invention. The structure of the system consists of a record, one or more profiles, and two interfaces. The first two elements are data structures. The interfaces also appear to be software per se:

...a **record**, which applicant labels "...a company-tailored prototypical product record..." the record appears to comprise a template (i.e., another record layout) and a variety of fields, which applicant refers to as "...information elements..." that is, data.

...**profile(s)**, which applicant refers to as "...user-indicative profile..." and "...company-indicative profile..."

...a [first] **interface**, which applicant refers to as "...internet-accessible purchasing interface that enables a [user, which applicant refers to as a company representative to do something]..."

...a [second] **interface** which applicant refers to as a "...internet-accessible requestor interface that enables a user to...[do something]..."

Again, the claim is directed to software per se. This interpretation is supported by claim 11, which states that the system further comprises a **server site** for hosting the two interfaces.

Claim 1 refers to company representative and user who may perform various functions. A user is one who uses. A company representative also uses the various interfaces. There appears to be no patentable distinction on how applicant uses the terms. For purposes of this Examination, the terms will be given their broadest reasonable interpretation to as users and will be treated as synonyms.

In claims 1, 3, 5 and 21, **enable** renders those claims indefinite. **To enable** is to provide with the means or opportunity, to make possible, practical or easy, to cause to operate, to give legal power, capacity or sanction to.² The Examiner notes that mere use of the term **enable** is not sufficient to meet the **enablement** requirement.

In claims 1, 21 and claims dependent thereupon, **predeterminable** and **predefined** are indefinite in that the terms appear to refer to actions that have taken place outside the metes and bounds of applicant's claims. Alternatively, the term refers to product(s) that result from processes, again outside the scope of the claimed invention.

² Definition of *enable* (v), MERRIAM WEBSTER'S Collegiate Dictionary.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **SEC filing** of 12 May 1999 by ImageX.com, downloaded from the Internet on 15 October 2004.

As per claim 1, **SEC Filing** discloses an automated print order system (*Online Printing Center*, page 18) for institutional business cards and stationery products (e.g., marketing brochures, stationery and business cards, page 4).

SEC Filing discloses that the system comprises:

1.1 company-tailored prototypical **record(s)** comprising a template (i.e., a record, as defined by applicant, page 9, lines 21-25) that defines the placement and typography of a plurality of informational elements printing on a company-tailored business card or stationery product. **prototypes** of customer's printed business materials and rules for Consistency of materials, as on page 42. See also page 5, which discloses that with custom present rules, business can let offices place their own orders, while controlling which **areas on a printed piece** (i.e., typography) can and cannot be modified. See also page 45, section entitled **ONLINE DATABASE OF COMPANY INFORMATION**, which discloses that **data is automatically incorporated into the text** of promotional marketing materials, office stationery and business cards. The stored types of data are available as templates and records.

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1.2 "predeterminable" profile(s) defining user-indicative and company indicative content for one or more of the informational elements provided by templates (records). See, for example, at least references to customer-specific and employee-specific data stored in various databases, page 45, *Online Database of Company Information* (applicant's profiles). The profiles are predeterminable in that profile data is provided prior to use.

1.3 internet-accessible interfaces. See, for example, at least page 40, concerning customized customer interfaces customer web sites. The interface(s) permit customers, customer representatives, employees and other users to perform various functions, including:

- "profile management" functions, such as specifying and modifying the company-indicative content of said profiles. See page 4, "...ImageX.com ...solutions that enable businesses to modify, proof, procure and **manage** custom printed business materials over the Internet." See, for example, at least page 45, which discloses that customers may make global changes to their online information or edit individual items that are stored in databases.
- "order processing" functions, comprising generating a *prepress* product automatically incorporating profiles into tailored product (s). See, for example, page 45, section entitled *ONLINE DATABASE OF COMPANY INFORMATION*, which discloses that **data is automatically incorporated into the text** of promotional marketing materials, office stationery and business cards, generating prepress products. The prepress products can then be routed directly to printing systems, as disclosed on pages 51-52,

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section entitled *DIRECT COST AND OVERHEAD COST REDUCTION*. See also Central management of orders, page 46. see also page 5, which discloses that print specifications are locked in for consistent quality.

SEC Filing's internet-accessible interface(s) permit users to perform additional functions, including:

- select one of the profile(s). See, for example, page 45, *ENHANCES CONTROL AND SCALABILITY*, which discloses that users such as employees may individually select and modify information in profiles. See also page 46, which shows that users can incorporate any new employee information into the databases and edit individual items.
- select and order a company-tailored business card or stationery product to be printed according to company-tailored prototypical product record and a selected [predeterminable] profile. See pages 45-46, which disclose that users can order broad range of printed materials.
- submit a print order for selected company-tailored business card or stationery product. See, for example, at least page 51, which discloses that the *Online Printing Center* permits users to submit orders into manufacturing systems.

SEC Filing discloses that interface(s) can also prevent (i.e., not enable) a user to do certain functions:

not enabling a user to modify typography of information to be printed on business card or stationery product. See, for example, at least page 5, which discloses that "...custom preset rules, business can let [users at] remote offices

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place their own orders, while controlling which areas on a printed piece [Ex. note: i.e., typography] **can and cannot** be modified.

As per claim 1, SEC Filing **does not** arrange the various functions and interfaces according to applicant's most recent rearrangement and nomenclature (i.e., purchasing [sic] interface, requestor interface, processor interface, profile management functions, order processing functions.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to classify various functions according to various interface(s), such as processor interface, a purchaser interface and a requestor interface, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

One of ordinary skill in the art at the time the invention was made would have been motivated to classify various functions and interfaces and apply nomenclature accordingly for the obvious reason that it is important to design a system and assign functions according to who (which actors) will be performing particular functions and provide various interfaces to facilitate use of the computer.

As per claim 2, SEC Filing discloses that *prepress* product comprises a direct-to-plate command set. See, for example, at least page 42, concerning press-ready digital files sent directly to plate.

As per claim 3, SEC Filing discloses that an interface enables a user to select only those products for which prototypical product records have been

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developed. SEC Filing disclose that users are restricted to selections available from a customized catalog, as disclosed on page 4.

As per claim 4, SEC Filing discloses user-indicative information includes the user's name and title. See, for example, at least references to Online Database of Company Information, page 45, that includes employee-specific data such as a name, position, title, etc.

As per claim 5, SEC Filing discloses not enabling a user to modify at least a portion of the company-indicative information of a selected profile. See, for example, at least page 5, which discloses that "...custom preset rules, business can let [users at] remote offices place their own orders, while controlling which areas on a printed piece [Ex. note: i.e., typography] **can and cannot** be modified.

As per claim 6, SEC Filing does not specifically disclose that a user's title is a pre-authorized title selected from a drop-down menu. Official Notice is taken that drop-down menus are old and well known and widely used on web site interfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine SEC Filing and general knowledge to disclose that a user's title is a pre-authorized title selected from a drop-down menu. One of ordinary skill in the art at the time the invention was made would have been motivated to combine SEC Filing and general knowledge to disclose that a user's title is a pre-authorized title selected from a drop-down menu for the obvious reason that doing so permits a site to restrict a user's choices according to its own business rules.

As per claim 7, SEC Filing discloses selectively authorizing generation of a *prepress* product, comprising generating a *prepress* product automatically incorporating profiles into tailored product (s). See page 5, for power to manager and release orders. See also page 45, section entitled *ONLINE DATABASE OF COMPANY INFORMATION*, which discloses that data is automatically incorporated into the text of promotional marketing materials, office stationery and business cards, generating prepress products. Prepress products can then be routed directly to printing systems, as disclosed on pages 51-52, section entitled *DIRECT COST AND OVERHEAD COST REDUCTION*. See also Central management of orders, page 46.

As per claim 8, SEC Filing discloses modifying profile(s). See, for example, at least page 8, *OUR BUSINESS*.

As per claim 9, SEC Filing discloses modifying a user's print order. See, for example, at least page 5, concerning secure order authorization that provides the power to **manage** and release orders online.

As per claim 10, SEC Filing discloses that customers manage their data and print orders, page 4, including modifying such orders. SEC Filing **does not** use the word **delete**. SEC Filing discloses print errors in prior art, and reduced errors in the Online print order system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine SEC Filing and general knowledge to include deleting a print order among the various managerial functions. One of ordinary skill in the art at the time the invention was made would have been motivated to combine SEC Filing and general

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knowledge to include deleting a print order among the various managerial functions for the obvious reason that ordering print products that are incorrect may be wasteful and annoying for both the online print center as well as the customer.

As per claim 11, SEC Filing discloses server site(s) for hosting said a customer's interfaces. See at least OUR BUSINESS, references to businesses having customized secure web sites, *Online Printing Center*, as in pages 8 and 18.

As per claim 12, SEC Filing discloses server sites resident upon the World Wide Web. See, for example, at least page 4, and references to secure World Wide Web sites.

As per claim 13, SEC Filing discloses that interfaces are accessible from any operable node on the World Wide Web. A node is a processing location on a network.³ On page 4, see at least references to "...from any Internet-enabled ...[node]..."

As per claim 14, SEC Filing does not specifically disclose server-side scripting implementation. The Examiner again notes that "...for increased user-to-server communication efficiency..." appear to be merely laudatory comments and as such carry little or no patentable weight. Official Notice is taken that scripting languages and server-side scripting implementations were old and well known to one of ordinary skill at the time the invention was made. It would have been obvious to one of ordinary skill at the time the invention was made to

³ Definition of *node*, RANDOM HOUSE WEBSTERS Computer and Internet Dictionary.

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combine SEC Filing and general knowledge to disclose server-side scripting implementation. One of ordinary skill at the time the invention was made would have been motivated to combine SEC Filing and general knowledge to disclose server-side scripting implementation for the obvious reason that such languages are designed to perform special or limited tasks.

As per claim 15, SEC Filing discloses the use of security protocols, including login in and password protection. See, for example, at least pages 9, 44, concerning security measures; see also page 42, concerning password protection, section entitled *Enhances Control and Scalability*. SEC Filing **does not** specifically disclose that logon security protocols are implemented via server-side scripting. Official Notice is taken that scripting languages are widely used on the World Wide Web to perform specific tasks. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine SEC Filing and general knowledge to disclose that logon security protocols are implemented via server-side scripting. One of ordinary skill in the art at the time the invention was made would have been motivated to combine SEC Filing and general knowledge to disclose that logon security protocols are implemented via server-side scripting for the obvious reason that scripting languages provide features such as readability that make is easy to program and debug.

As per claim 16, SEC Filing discloses batch functions, including batch functions adapted to control generation of a *prepress* product. See, for example, at least references to batching, page 42. See, for example, at least page 5,

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concerning secure order authorization that provides the power to manage and release orders online; customers can batch their orders online.

As per claim 17, SEC Filing discloses storing a user's order. See, for example, page 5, which disclose that customers can modify, release, batch their orders online. See also references to order history and orders in production. This shows that customer orders are stored. SEC filing **does not** specifically disclose that the information is stored in a table, or that the table is labeled "order data table" or that the data contains elements to reference said a profile. SEC Filing **does not** specifically disclose that such data may be stored in tables, a data structure in a relational database.⁴ SEC Filing discloses the use of relational databases such as ORACLE relational databases that hold and manage all ordering rules, content information and process data, page 51. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine SEC Filing and general knowledge to disclose the use of tables, and specifically, order tables. One of ordinary skill in the art at the time the invention was made would have been motivated to combine SEC Filing and general knowledge to disclose the use of tables, and specifically, order tables for the obvious reason that Oracle relational databases and tables provide scalable solutions for enterprise data management.

As per claim 18, SEC Filing discloses that batch functions may be adapted to import information from a profile into files according to reference elements of an order profile, and that the file may then comprise a complete

⁴ Definition of *table*, MICROSOFT PRESS Computer Dictionary.

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specification of a tailored product. See, for example, references to print-ready prepress products, page 9, press-ready digital files (page 42), print-ready digital files, (page 43, Streamlines Manufacturing), print-ready PostScript files (page 51, *Direct Cost and Overhead Cost Reduction*), press-ready digital files sent directly to Plate (page 114). SEC Filing **does not** specifically disclose that such actions are carried out via batch **tables**. A table is a data structure in a relational database.⁵ SEC Filing discloses the use of relational databases such as ORACLE relational databases that hold and manage all ordering rules, content information and process data, page 51. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine SEC Filing and general knowledge to disclose the use of tables, and specifically, order tables. One of ordinary skill in the art at the time the invention was made would have been motivated to combine SEC Filing and general knowledge to disclose the use of tables, and specifically, order tables for the obvious reason that Oracle relational databases and tables provide scalable solutions for enterprise data management.

As per claim 19, SEC Filing discloses batch function(s) to format specifications for a tailored product into a *prepress* product. Where prepress products are produced, the specifications are prepress product compatible. This claim is rejected on the same grounds as claim 7.

As per claim 20, SEC Filing discloses that company-tailored product(s) may comprise business media selected from the group consisting of. letterhead;

⁵ Definition of *table*, MICROSOFT PRESS Computer Dictionary.

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business card; envelopes; writing pads; address cards; and mailing labels. See at least page 4, concerning marketing brochures, stationery and business cards).

As per claim 21, SEC Filing discloses automated print order system for institutional business cards, stationery products (*Online Printing Center*, page 18)

As per claim 21.1, *SEC Filing* discloses a computerized representation of a set of printable stationery products. See at least page 45, concerning customized online catalog that displays an image of a product, section entitled *ONLINE CATALOG OF PRINTED BUSINESS MATERIALS*.

As per claim 21.2, *SEC Filing* discloses customized **templates** corresponding with each stationery product in the set, wherein the **templatee** defines a plurality of common and specific informational elements for printing on the stationery product wherein the **templatee** also defines the placement and **typographical** settings of the informational elements to be printed on the stationery product. A template is a record (specifications, page 9, lines 21-25). Records are data structures that format data. SEC Filing discloses **prototypes** of customer's printed business materials and rules for Consistency of materials, as on page 42. See also page 5, which discloses that with custom present rules, business can let offices place their own orders, while controlling which **areas on a printed piece** (i.e., typography) can and cannot be modified. See also page 45, section entitled *ONLINE DATABASE OF COMPANY INFORMATION*, which discloses that **data is automatically incorporated into the text** of promotional marketing materials, office stationery and business cards. The stored types of data are available as templates and records.

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As per claim 21.3, *SEC Filing* discloses predefined informational content for the common informational elements of the customized **templates** including for at least one of the common informational elements informational content that identifies a specific organization. See, for example, references to logos, page 45.

As per claim 21.4, *SEC Filing* discloses **interface(s)** for entry of print order by a user associated with the specific organization. See rejection of claim 1.

- enable the user to select a stationery product from the set of printable stationery products. select and order a company-tailored business card or stationery product to be printed according to company-tailored prototypical product record and a selected [predeterminable] profile. See pages 45-46, which disclose that users can order broad range of printed materials.
- enable the user to define (see references to new employee, page 43) or select a profile comprising informational content for the specific informational elements of the customized **templates**

SEC Filing discloses that interface(s) can also prevent (i.e., not enable) a user to do certain functions:

not enabling a user to modify typography of information to be printed on business card or stationery product. See, for example, at least page 5, which discloses that "...custom preset rules, business can let [users at] remote offices place their own orders, while controlling which areas on a printed piece [Ex. note: i.e., typography] **can and cannot** be modified.

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As per claim 21.5, *SEC Filing* discloses **interface(s)** for fulfillment of the user's print order:

- generating a *prepress* product automatically incorporating profiles into tailored product (s). See, for example, page 45, section entitled *ONLINE DATABASE OF COMPANY INFORMATION*, which discloses that ***data is automatically incorporated into the text*** of promotional marketing materials, office stationery and business cards, generating prepress products. The prepress products can then be routed directly to printing systems, as disclosed on pages 51-52, section entitled *DIRECT COST AND OVERHEAD COST REDUCTION*. See also Central management of orders, page 46. see also page 5, which discloses that print specifications are locked in for consistent quality.
- informational content from the user-defined or user-selected profile including the user's name and title. See, for example, at least references to Online Database of Company Information, page 45, that includes employee-specific data such as a name, position, title, etc.

As per claim 22, *SEC Filing* discloses **templatee** are customized for a business organization. See, for example, references to customized print products, as on page 41. The elements may comprise a graphical representation of a business organization logo, page 42.

As per claim 23, *SEC Filing* discloses the user of common informational elements such as graphical representation of a business organization logo. See at least page 42, references to graphics and logos.

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As per claim 24, *SEC Filing* discloses interface(s) adapted to process the user's print order by merging the defined or selected profile with the template of the selected stationery product to automatically generate the *prepress* product. This claim is rejected on the sale grounds as claim 16.

As per claim 21, SEC Filing **does not** arrange the various functions and interfaces according to applicant's most recent rearrangement and nomenclature (i.e., purchasing [sic] interface, requestor interface, processor interface, profile management functions, order processing functions.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to classify various functions according to various interface(s), such as processor interface, a purchaser interface and a requestor interface, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

One of ordinary skill in the art at the time the invention was made would have been motivated to classify various functions and interfaces and apply nomenclature accordingly for the obvious reason that it is important to design a system and assign functions according to who (which actors) will be performing particular functions and provide various interfaces to facilitate use of the computer.

Response to Arguments

Objections to the drawings are withdrawn in view of amendment.

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First and second paragraph rejections under 35 USC 112 are withdrawn in view of amendment to the claims and explanation of various terms.

Applicant attempts to overcome the rejection by disqualifying Lavery as prior art with an affidavit under 37 CFR 1.131 is not effective for reasons explained below.

37 CFR 1.131 Declaration

The affidavit/declaration of Lopez and Rodriguez filed on 20 April 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome Lavery (US 6791707) and SEC filing of 12 May 1999.

Failure to establish diligence

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Lavery reference to either a constructive reduction to practice or an actual reduction to practice.

An applicant must account for the entire period during which diligence is required." *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). Statements that the subject matter "was diligently reduced to practice" is not a showing "but a mere pleading." *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964). Diligence requires that Applicants must be specific as to dates and facts. *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949). (Also see MPEP 2138.06).

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Lacks NAFTA/WTO allegation

The affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. (See MPEP 715.07(c) and 35 U.S.C. 104).

Failure to establish conception

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the PR Newswire reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

In the **present case**, the applicants have not properly supported their conception of the invention through sketches, notebook entries, programming code, etc.

Failure to reduce to practice (Actual)

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the PR Newswire reference. An actual reduction to practice requires a showing of the invention in a physical or tangible form that shows

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every element of the count. See *Wetmore v. Quick*, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985); (Also see MPEP 715.02 and 715.07).

Additional evidence may be provided in the form of test results for unit testing, string testing, user acceptance testing, production testing. For example, such results may include hash totals, number of input records, expected output, correction of detected errors, etc. for each of unit test region, UAT region, production region. In contrast, the documents fail to show web page flows for internet profile management interfaces accessible to selected institutional representatives. There is no provision of results for testing accessibility restrictions to various levels of users, for example.

Lacks Signature or Punishment Paragraph

The affidavit submitted by the applicants is defective because the clause regarding "willful false statements..." required by 37 CFR 1.68 has been omitted.

Lack of Drawings and/or Explanation

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37 CFR 1.131(b) states "Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained."

In the present case, the Applicants have neither provided the Patent Office with drawings, records, or photocopies nor have they satisfactorily explained the absence of such documents.

Miscellaneous Issues, Lopez and Rodriguez Statements

In addition to the above, the Examiner notes the following problems.

Lopez Affidavit

Item 3, the priority date of Lavery (US 6791707) is 10 January 2000, not December 19, 1999, as stated by Mr. Lopez in item 3 of his statement.

Item 4, Exhibit C, dated 6/10/99, 2 pages, shows a form entitled "Create Service Center Profile," **sc_createprofile.asp**. These 2 pages appear to correspond to item 4(2). There is no mention on other properties listed by applicant.

Item 5, Exhibit D, dated 6/10/99, 1 page and 1 screen shot, appears to be a welcome page for KCI.

Item 6, Exhibit F, undated, is purported to show a preview of a business card.

Item 7, Exhibit X, 11 undated pages, shows detailed Billing Statement purportedly generated on 10/9/99. These do not appear to be screen shots, since each page shows handwritten notes at the bottom.

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Item 8, Exhibit Y, dated 9/3/99, ***billing_generate.asp***, is described as a screen shot as it appeared on 9/9/99. The figure shows that the items are issued for one individual, Leslie Litrell, RN. Applicant also refers to an ***Exhibit I***, which is not otherwise mentioned or shown.

Item 9, Exhibit Z, is described as an invoice for Exhibits X and Y. The \$35.00 charge appears to correspond to Ms. Litrell's cards.

The Examiner notes that the Lopez statement includes an unidentified page just prior to Exhibit Y. The page appears to be a facsimile copy of a document transmitted on 8/19/99.

Rodriguez affidavit

Item 5, Exhibit C, dated 6/10/99, 2 pages, appears to correspond to Lopez Exhibit C.

Item 6, Exhibit D, dated 6/10/99, 1 page, appears to correspond to Lopez Exhibit D, a welcome page. Only the words YES/NO appear to be hyperlinks.

Item 7, Exhibit G, 1 page, dated 9/3/99, appears to be a billing statement and appears to correlate to Lopez Exhibit Y, described above.

Item 8, Exhibit H, dated 9/7/99, appears to correspond to Lopez Exhibit Z.

Item 9, Exhibit I, 11 pages, dated 10/8/99, ***billing_generate.asp***, appear to correspond to Lopez Exhibit X. Again, these do not appear to be screen shots, due to hand-written notes at the bottom of each page. The Examiner believes this document may correspond to Lopez Exhibit I, which is not found.

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Item 10, Exhibit J, a printed invoice for \$3920.95, appears to correspond to detailed information in Exhibit I.

For these reasons, the declarations are rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 3625
10 July 2005

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